Remarks

[01] Reconsideration of the pending application is respectfully requested.

[02] Applicant sincerely thanks the Examiner for granting an in-person interview on September 20, 2005, in the midst of the busy September schedule. Applicant also finds the Examiner's comments on various aspects of the claims to be quite helpful, and have amended the claims to more clearly claim Applicant's invention.

[03] Claims 19-36 have been amended to more distinctly claim the present invention. No new matter is introduced.

[04] Claims 37 and 38 are added. Claim 37 recites a corporate customer (entity customer) issuing e-mail addresses with a common domain name, which can be used for authentication purposes. (Specification, para. [0050]). Claim 38 recites a payment method where the fee is attached to the reader's phone bill. (Specification, para. [0057]).

[05]

[06] Rejections under Sec. 102 (e)

[07] Claims 19-23, [2]5, 27-29, 31 are rejected under 35 USC Sec. 102 (e) as being anticipated by Bengtson. Applicant respectfully traverses the rejection for the reasons that Bengtson does not teach the claimed invention.

[08] The Invention.

[09] The present invention is directed to facilitating a newspaper (or magazine) reader to quickly retrieve a printed article in portable electronic format via e-mail, after the user has first read or observed the article in printed paper form. For example, a reader of the Food Section or Op-Ed Pages of the Los Angeles Times in paper format may wish to save an article about a recipe or an Essay for future reference, or forward the article to a friend. The conventional way is to physically clip and copy the paper article, which is quite tedious and not conducive for filing or forwarding.

[10] The present invention achieves the goal in a much efficient and useful way, and can be achieved without requiring the reader to have immediate access to a computer. To that end, the article is first assigned to a unique tag by its publisher prior to printing. When the article is printed in paper format by the publisher, the tag is also printed near the location of the article in paper format. The publisher also publishes ways of retrieving the article: a web site, an e-mail

address and a telephone number. At the reader's side, the reader pre-registers either his e-mail address or phone number with the publisher for authentication and delivery purposes.

[11] Upon observing an article on paper the reader desires to keep, all the reader needs to do is to i) use the tag in an e-mail request to the publisher, ii) enter the tag by calling the publisher's designated telephone number from the reader's pre-registered telephone number, or iii) use the tag to download from the publisher's designated web site. Upon receiving the request through any one of the channels, the publisher can easily authenticate the reader based on the reader's pre-registered e-mail address or telephone number. Then a portable electronic format of the article, e.g. PDF, is e-mailed to the reader's pre-registered e-mail address. The retrieval based on the pre-assigned printed tag is much more convenient and efficient, especially when the reader can still make the request, through a wireless or landline telephone, without having a computer nearby. After making the request via a telephone or e-mail, the article in electronic portable format is automatically retrieved and transmitted to the reader's e-mail address. Now, with the portable electronic form of the article, the reader can save it in his own computer files (where key words can be easily assigned for subsequent retrieval), or forward to his friends and associates (where, additionally, the readability of the article is maintained).

[12] The pre-registration of the reader's e-mail address and telephone number allows authentication and delivery to be done directly, without requiring the reader to enter more information than the tag(s) in his request. If the request is in e-mail, the reader's own e-mail address can be used for both authenticated and delivery. If the request in from the reader's telephone number, the reader's telephone number, e.g. Caller ID, is used for authentication and the reader's pre-registered e-mail address is used for delivery.

[13] The Bengtson Reference.

[14] Bengtson discloses serving a web page to a client device based on search index generated from print data received from the publisher. However, the dynamic web page or IP address, in contrast to a static portable electronic document, may change over time, thus leading to an invalid source. Also, the search index is based on print data received from the publisher, where the print data is generated after the article is already published in print. No tag is printed with the article in Bengtson's scenario. To create the search index, the received print data is parsed into key words or phrases, searched for words associated with special attributes and then created by storing page numbers associated with the key words. Then a link database is created by receiving and storing the network links, e.g. IP addresses. (Bengtson, page 6, paragraphs [0046]-[0049]) The operation of Bengtson is heavily dependent on the validity of the web page

links maintained in the publication link server (104).

[15] The Mayadas Reference.

[16] Mayadas discloses a payment methodology for targeted messaging over a network. Advertisers pay into the system to have their messages distributed according to specified criteria. Payment is made to the users if they view the targeted message. Message publishers are also compensated for publishing the targeted messages. While it discloses a payment scheme, Mayadas' payment is made to the readers for reading the messages. The payment is not for the readers to pay for their retrieved articles using a request with a tag. Even if Mayadas can be combined with the teaching of Bengtson, the resulting system still make the present invention as claimed in claims 30, 32, 33-36 obvious.

[17] Main Distinctions.

[18] The present invention, as claimed, is distinguishable over the primary reference Bengtson with respect to at least the following salient features:

[19] a. The unique tags are pre-assigned by the publisher, and printed in paper form with the articles. (Specification, para. [0034]). No post-print parsing and extraction is needed. Bengtson has to generate its search index from the print data received from the publisher, after the article has been printed in paper. (Bengtson, col. 6, para. [0047]-[0048]). Bengtson's search index is not the same as the publisher-generated and –printed tag of the present invention.

[20] b. The present invention's publisher also indicates an e-mail address, a telephone number or a web site for retrieval. As such, a request from an interested reader can be made through web site download, e-mail request, or telephone request. (Specification, para. [0047], [0052], [0056], [0058]). Requests can be easily transmitted from the reader by making a telephone call to a publisher pre-assigned telephone number, even when the reader is away from his PC. Upon recognizing the reader's telephone number, e.g. through Caller ID, the request is filled by transmitting the requested article to the reader's e-mail box. (Specification, para. [0024], [0056], [0057]). Bengtson does not teach such retrieval methods, either using an e-mail or one through a telephonic gateway. Bengtson only allows its readers to access the link server by receiving the web page when the client is on-line, whereas the present invention does limit to the client being on-line. The request of the present invention can be sent via a telephone call, off-line.

[21] c. The reader in the present invention pre-registers his e-mail address or telephone number with the publisher for authentication. (Specification, para. [0056], [0052]). This pre-registration allows the publisher to authenticate the reader's tag request, since the request is made

from a pre-registered telephone (wired or wireless) number, or from a pre-registered recognized e-mail address. To determine a reader's identity, Bengtson needs to rely on a cookie or log-in. (Bengtson, col. 6, para. [0053]). Bengtson does not disclose such pre-registration using either telephone numbers or e-mail addresses. Also, Bengtson does not disclose using the received Internet client's telephone number or e-mail address as authentication.

[22] d. The retrieved article is e-mailed to the reader's e-mail box in portable electronic format, which is a static file, as opposed to the target network address, or web page, used by Bengtson. (Bengtson, col. 6, para. [0052]-[0053]; Fig. 6, blocks 606, 608). Before the web page can be sent to Bengtson's readers, the target network address must be determined based on a client query, the search index, and the link database. Once the network address is found from the link database (104), the web page associated with the target network address is transmitted. (Bengtson, col. 6, para. [0051]-[0053]). No such target network address or web page is used in the present invention's retrieval, since the invention seeks to avoid the dependency on the dynamic web pages. (Specification, para. [0015]).

[23] e. For readers within a corporate customer, e.g. smith@uspto.gov, jones@aol.com, or doe@yahoo.com, the common domain name serves as a way to authenticate their right to retrieve the article in electronic format from the publisher. (Specification, para. [0033]). Such group authentication is much more efficient and powerful than any individualized registration.

[24] <u>The Claims:</u>

[25] Claim 19, as amended, is not anticipated by Bengtson because Bengtson does not disclose:

[26] - The articles are pre-assigned to tags by the publisher, which are also printed with the articles when the newspaper or magazine is published in paper form. The tag is not generated by parsing the print data from the publisher as in Bengtson.

[27] - The publisher provides information about retrieval methods: by web site, by e-mail or by telephone.

[28] - A request, with the tag, is made to the web site, the e-mail or the telephone number provided by the publisher. The request also includes either the reader's e-mail address or telephone number, where the reader has pre-registered with the publisher his e-mail address or telephone number.

[29] - Authentication of the request by the publisher is done on either the e-mail address from which the reader sends the request, or the telephone number from which the reader dials the

request.

[30] - The article in portable electronic form (vis-à-vis Bengtson's web page and target network address) is retrieved based on the tag, and then forwarded to the reader's e-mail box.

[31] Claims 20 and 29 are not anticipated by Bengtson (Bengtson, page 4, [0037]) because Bengtson does not disclose bundling additional information, which is relevant to the subject matter of the article, from another server (Specification, para. [0060]), in real-time or in static form, to the portable electronic form of the article. Bengtson transmits the web page related to the target network address and teaches nothing about bundling relevant information to the article, where the relevant information is provided in real-time or otherwise by another server.

[32] Claim 21 is amended to be dependent from claim 23. Claim 21 recites bundling relevant information to the reader's profile information when an electronic portable form of the article is delivered to the reader. Bengtson does not disclose such relevant information to the reader-supplied profile information in the delivery mode. (Bengtson, col. 5, col. 1, lines 8-10). The 'profile information' in Bengtson cited by the Examiner refers to information indicated in the print data from the publisher as a way to help build the search index. The reliance by the Examiner is inapplicable.

[33] Claim 22, which is dependent on claim 21, as amended recites bundling relevant information during delivery of the article. Bengtson discloses associating various links with pages and chapters of the book when building its link database (Bengtson, col. 5, [0042], lines 1-7). The reliance by the Examiner is inappropriate.

[34] Claim 23, which is dependent on claim 20, has been amended to recite the reader's pre-registration of his telephone number and/or e-mail address, which are also used for authentication when a request is received by the publisher at the publisher's web site, e-mail address or telephone number. Examiner erroneously cited Bengtson at page 5, col. 1, [0041], lines 5-8, which discloses the use of a user name and a password to the link administrators for submitting publication links. It is for administration's adding to the link server, which is not the same as what is claimed for the delivery to the reader. It does not disclose what the user/reader does to pre-register and what the publisher does for authentication of the reader for retrieval purposes.

[35] Claim 25, which is dependent on claim 23, is amended to clarify that a request is transmitted from the reader to the publisher through a wireless or wired telephone connection. Bengtson (pg. 3, col. 1, 0022, lines 1-7) does not disclose the request being made by the reader in a telephone call to the publisher's phone number, where authentication is done based on the reader's pre-registered e-mail address or telephone number.

[36] Claim 27, which is amended to be dependent on claim 26, recites additional tags assigned by the publisher before the article is printed. Bengtson's code is generated from the print data received from the publisher and is associated explicitly with a "target network address" pointing to a web page. (pg. 3, col. 2, 0026, lines 5-10; Fig. 7, right column). The invention's tags are associated with the static portable electronic document, which does not depend on a web page. As such, the dependency on the validity of the link is removed in the invention, whereas Bengtson's operation depends on the link or network address to remain valid.

[37] Claim 28 as amended is directed to providing a retrieval methodology for a plurality of publications through an aggregator, who manages the database storing the electronic documents. (Specification, [0054]). Bengtson fails to disclose:

[38] - The articles are pre-assigned to tags by the publisher, which are also printed with the articles when the newspaper or magazine is published in paper form. The tag is not generated by parsing the print data from the publisher as in Bengtson.

[39] - The publisher provides information about retrieval methods through an aggregator: by web site, by e-mail or by telephone.

[40] - A request, with the tag, is made to the web site, the e-mail or the telephone number of the aggregator. The request also includes either the reader's e-mail address or telephone number, where the reader has pre-registered with the aggregator his e-mail address or telephone number.

[41] - Authentication of the request by the aggregator is done on either the e-mail address from which the reader sends the request, or the telephone number from which the reader dials the request.

[42] - The article in portable electronic form (vis-à-vis Bengtson's web page and target network address) is retrieved based on the tag, and then forwarded to the reader's e-mail box by the aggregator.

[43] Claim 31, which is dependent on claim 30, is amended to recite transmitting a request from the reader's telephone number, such that the telephone number can be used for authentication purposes. Bengtson fails to disclose using a simple telephone call to the aggregator's phone number for making a request, whereafter the article is e-mailed based on authentication of the reader's telephone number.

[44] Rejections of claims 24, 26 under Sec. 103

[45] Claims 24, 26 are rejected as being unpatentable over Bengtson in view of Carden. For the discussion relating to Bengtson, Applicant respectfully directs the Examiner to the above paragraphs.

[46] Claim 24, which is dependent on claim 20, is amended to further recite that the reader's request includes the tag in the SUBJECT field of the e-mail. No such use of the tag in the SUBJECT field is disclosed. Additionally, by combining Carden with Bengtson, the resulting system, which does not seem to have any motivation for medication, still only provides a web page to the reader via e-mail, whereas the present invention provides a portable electronic document to the reader based on the reader's request with the tag in the SUBJECT field. Therefore, the rejection of claim 24 based on Bengtson in view of Carden is inappropriate and should be withdrawn.

[47] Claim 26, which is dependent on claim 23, is amended to further recite that a request is made by the reader placing a telephone call to the pre-assigned telephone number, where authentication is made based on the reader's telephone number. The resulting system, which does not have any motivation for modification, is still not the same as claimed. Therefore, the rejection of claim 26 based on Bengtson in view of Carden is inappropriate and should be withdrawn.

[48] Rejection of claims 30, 32 under Section 103

[49] Claims 30, 32 are rejected as being unpatentable over Bengtson in view of Mayadas. For the discussion relating to Bengtson, Applicant respectfully directs the Examiner to the above paragraphs.

[50] With respect to claim 30, Bengtson does not teach pre-registering the readers (Internet clients) and authenticating based on the reader's e-mail address, access code and telephone number.

[51] With respect to claim 32, Bengtson and Mayadas do not teach responding to a request made by a telephone connection using the telephone number provided by the publisher. Bengtson discloses only accessing the web site of the publisher via PDA for retrieving the web page. Bengtson does not disclose making the telephone connection and receiving the document in the reader's e-mail box.

[52] For the above reasons, the rejection under Sec. 103 is inappropriate and is requested to be withdrawn.

[53] Rejections of claims 33-36 under Sec. 103

[54] Claims 33-36 are rejected under Sec. 103 as being unpatentable over Bengtson and Mayadas. In addition to the discussion provided above, Applicant points that that Bengtson fails to disclose the corporate (entity) customer, such as XXX@uspto.gov, YYY@yahoo.com, which issues e-mail addresses with a common domain name to affiliated Internet clients, e.g. employees or subscribers. With the common domain name, authentication can be easily done by recognize the domain name in the Internet client's e-mail address. (Specification, para. [0050]) Such entity customer provides another aspect of the convenience for quick authentication and retrieval. For employees from a corporate or subscribers of an ISP, using a telephone to make a request is impractical, since it would require everyone to register its own telephone number. However, since all employees will have the same domain name, or all subscribers will have the same ISP domain name, it would be much more efficient. Bengtson does not disclose, nor teach, such methodology when dealing with Internet clients with common domain names.

[55] With respect to Mayadas, as previously discussed, its payment scheme is from the advertisers to the Internet clients based on the targeted messages they are willing to read. The payment scheme in the present invention is for the corporate customer to pay the publisher based on the number of the Internet clients.

[56] For the above reasons, it would not have been obvious to modify Bengtson with Mayadas to arrive at the methods claimed by the present invention. There is no motivation to do so and even if they were combined, the resulting system would still be quite distinguishable from the claimed invention. The rejections under Sec. 103 should be withdrawn.

[57] **Conclusion**

[58] From the above discussion, Applicant has explained that the present invention is patentable and novel over Bengtson, Carden and Mayadas. Withdrawal of the Examiner's rejections and granting of allowance is respectfully requested.

[59] The Examiner is encouraged to contact the undersigned to discuss any matter regarding the present application at Tel: 626-965-1202.

Respectfully Submitted,

By Philip K. Yu, Reg. Patent Attorney

Reg. No. 35,742

Applicant

For Correspondence:

Customer No. 30781

Tel: 626-965-01202

20955 Pathfinder Road, Ste. 100

Diamond Bar, CA 91765

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By _____

Philip K. Yu, Reg. No. 35,742